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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,671	04/16/2004	Michael Chen	03224.0006U2	9595

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NEEDLE & ROSENBERG, P.C.  
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ATLANTA, GA 30309-3915

EXAMINER
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PARRA, OMAR S

ART UNIT	PAPER NUMBER
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2623

MAIL DATE	DELIVERY MODE
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10/16/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<p align="center"><b>Office Action Summary</b></p>	<b>Application No.</b> 10/826,671	<b>Applicant(s)</b> CHEN ET AL.	
	<b>Examiner</b> Omar Parra	<b>Art Unit</b> 2623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)<br>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)<br>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>05/22/2007; 11/24/2004</u> . | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____<br>5) <input type="checkbox"/> Notice of Informal Patent Application<br>6) <input type="checkbox"/> Other: ____ |
|---|--|

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims **1-5, 9-29 and 33-47** are rejected under 35 U.S.C. 102(e) as being anticipated by Holtz et al (hereinafter 'Holtz', Patent No. 6,760,916).

Regarding claims 1, 13, 17, 25 and 36, Holtz teaches having an apparatus (with respective method) for creating at least one targeted integrated image for delivery to a user, the apparatus comprising:

a processor for determining content of potential interest to the user based on at least one user preference, prior to or during the user's request for a first image or while the user is receiving the first image, and selecting a second image representing the content of potential interest to the user (**Streaming server 125 in Fig. 1, upon Enhanced media server 115 request, searches for content on the fly that a user requested - col. 9 lines 21-36. Advertisement server 135 provides advertisement to be put together with selected content - col. 9 lines 45-54; col. 16 lines 34-63. The advertisement is targeted and sent to users who are more likely to purchase**

**certain item -col. 18 lines 35-67. The selected content could also be selected and put together prior user's request and based on the user profile and preferences-col. 13 lines 3-39). ; and**

a combiner for combining the second image with the first image or a third image to form a targeted integrated image for delivery to the user (**Enhanced media server 115, Fig. 1; col. 16 line 15- col. 17 line 5; col. 25 lines 34-58**).

Regarding claims 2 and 26, Holtz teaches an apparatus (with respective method), wherein the second image is a barker advertising the content of potential interest to the user (**col. 9 lines 45-54; col. 34 lines 20-61**).

Regarding claims 3,4, 27 and 28, Holtz teaches an apparatus (with respective method), wherein the user preference includes information representing content viewing habits or content ordering habits of the user (**col. 18 lines 35-55; col. 32 lines 32-64; col. 37 lines 43-63; col. 44 lines 46-53**).

Regarding claims 5 and 29, Holtz teaches an apparatus (with respective method), further comprising determining an identity of the user, wherein the content of potential interest to the user is determined based on an at least one user preference associated with the identity of the user (**Fig. 12 or col. 44 lines 1-24. Given that you have to login to access the content with a login, and that the tracking of the behavior of the user for creating a profile is performed when having the content,**

**inherently, the profile is related to the login shown at Fig. 12).**

Regarding claims 9 and 33, Holtz teaches an apparatus (with respective method), wherein the first image includes at least a menu or a programming guide **(The menu or listing 1104 is sent from the server to be displayed to the user as in Fig. 11, 12 and 13; col. 8 line 24-col. 9 line 20. Holtz also teaches that the user can complete a specification -menu- to customize the desired content -col. 31 lines 27-56).**

Regarding claims 10, 11, 34 and 35, Holtz teaches an apparatus (with respective method), wherein the step of determining is initiated in response to the user accessing the menu or programming guide **(col. 31 line 27-col. 32 line 64; col. 16 line 15- col. 17 line 5; col. 25 lines 34-58. Given that the profile is formed with the selection, and viewing of ads and content; the list or menu, which represents the available content, will change the profile and the future material selection).**

Regarding claims 12-14 16, 36-38 and 40, Holtz teaches an apparatus (with respective method) wherein the step of determining is initiated responsive to the user requesting the video content **(col. 16 line 15- col. 17 line 5, col. 25 lines 34-58, abstract).**

Regarding claims 18-20 and 41-43, Holtz teaches an apparatus (with respective method) further comprising repeating the steps for creating at least one new targeted

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integrated image for delivery to the user; wherein the steps are repeated as the user continues to request or receive images or wherein the steps are recursively repeated for delivering new targeted integrated images for delivery to the user (col. 13 lines 3 -39.

**Given that the profiles dynamically change and that the user can change the preferences -col. 31 line 18 -col. 32 line 31, it is inherent that the matching content will be different and new).**

Regarding claims 21 and 44, Holtz teaches an apparatus further comprising compressing at least one of the first image, the second image, and the third image prior to forming the targeted integrated image (col. 25 line 60-col. 26 line 16).

Regarding claims 15, 22-24, 39 and 45-47, Holtz teaches an apparatus (with respective method) wherein the combiner inserts the second image within the first image or the third image, wherein the first image or the third image is adapted to appear to the user to be paused, for delivery or upon delivery (**Given that user can 'trick-play' the content, including pausing it -col. 42 lines 10-39- , that the content is sent together with the advertisement and that the advertisement and other enhanced data could be watched in a different display next to the content display- col. 35 lines 3-23; col. 38 lines 34-50, it is inherent that the ads or other enhanced data can be inserted while the actual video appears paused to the user. In other words, the enhancement content can be viewed at the display next to the paused video display).**

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6- 8 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holtz et al. (hereinafter 'Holtz', Patent No. 6,760,916) in view of Plotnick et al. (hereinafter 'Plotnick', Pub. No. 2002/0184047).

Regarding claims 6- 8 and 30-32, Holtz teaches all the limitations of the claims they depend on. On the other hand, Holtz does not teach selecting the second image from a queue and the steps of manipulating the images of the queue.

However, in an analogous art, Plotnick teaches selecting the second image from a queue (UAQ or [0011], [0014]). Plotnick also teaches the steps of determining content previously ordered or viewed by the user (In the same way as Holtz, Plotnick teaches keeping track of user's preferences and selections to get ads -[0083]- but, also controls what ads were played or viewed -[0061]-; determining images available in the queue, removing images related to the previously ordered or viewed content from the queue ([0151]). Moreover, Plotnick teaches marking the second image delivered to the user as having been delivered; and placing the marked image at the end of the queue, wherein the step of selecting selects images sequentially from the beginning of the queue

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([0061]).

Therefore, it would have been obvious to an ordinary skilled in the art at the time of the invention to have modified Holtz' invention with Plotnick's capability of queuing the targeted ads for the benefit of a fast insertion process.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Omar Parra whose telephone number is 571-270-1449. The examiner can normally be reached on Under Academy Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



OP



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